

REMARKS

Favorable reconsideration of this application in light of the preceding amendments and the following remarks is requested.

Claim 1 having previously been canceled and claims 2, 40 and 41 having been canceled in the amendments to the claims reflected above and no claims having been added, the Applicants submit that 47 claims, specifically claims 3-39 and 42-51, remain pending and properly under consideration in this application.

The Applicants submit that the amendments to claims 5, 27 and 36 above are supported by at least claims 1-7 and 40-41 as originally filed. The Applicants also contend that the amendments to claim 5 necessary to incorporate the limitations of the claims from which it depended and thereby present claim 5 in independent form do not present any new matter or issue that would require additional searching. Indeed, the Applicants note that claim 5, as originally filed, depended indirectly from claim 1 and thus already encompassed the method recited with respect to the oxidant solution of ozone while claim 7, which also depended indirectly from claim 1, recited an alternative oxidant solution of hydrogen peroxide that has been incorporated into the Markush group identified in claim 5.

The Applicants further submit that the amendments above to those dependent claims that originally depended from claim 2 to depend directly or indirectly from claim 5 simply reflects the cancellation of claim 2 and the incorporation of the subject matter of claim 2 into claim 5.

The Applicants also contend that support for the amendments to claims 3 and 38 with respect to the presence of secondary oxidants is found in at least paragraph [0018] of the Specification as originally filed and does not, therefore, represent the introduction of new matter.

The Applicants note with appreciation the Examiner's indication that the drawings filed August 10, 2003, are acceptable. Action at 2.

The Applicants acknowledge that the application currently names joint inventors and contends that the subject matter disclosed and claimed herein was commonly owned at the time the inventions were made. Accordingly, while the Applicants acknowledge their obligations under 37 C.F.R. § 1.56 regarding the accurate designation of inventorship, they contend that no correction or supplemental information is warranted at this time.

Rejections under 35 U.S.C. § 102

Claims 2, 3 and 4 stand rejected under 35 U.S.C. § 102(b) as anticipated by Matsuo et al.'s U.S. Patent No. 6,083,860 ("Matsuo").

The Applicants submit that the cancellation of claim 2 and the amendment to claims 3 and 4 to depend from claim 5 reflected in the amendments to the claims presented above renders this rejection moot. The Applicants, therefore, request that the rejection be reconsidered and withdrawn accordingly.

Rejections under 35 U.S.C. § 103

Claims 7, 10-16, 21-27, 29, 30, 36-39, 41-46 and 48-51 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Matsuo. The Applicants traverse this rejection for the reasons detailed below.

The Applicants note that, as amended, the oxidant solutions recited in independent claims 5, 27 and 36 are selected from:

. . . ***an aqueous ozone solution***, the concentration of ozone being between about 1 ppm and about 200 ppm, and ***an aqueous hydrogen peroxide solution***, the concentration of hydrogen peroxide being between about 0.5 weight percent and about 30 weight percent

Claims 5, 27 and 36, as amended (emphasis added). The Applicants further note that Matsuo identifies as potential “catalysts” a number of compounds including:

. . . ***amines*** such as triethylamine, diethylamine, monoethanolamine, diethanolamine, triethanolamine, n-hexylamine, n-butylamine, di-n-butylamine, tri-n-butylamine, guanidine, piguanine, imidazole, 1,8-diazabicyclo-[5.4.0]-7-undecene and 1,4-diazabicyclo-[2.2.2]-octane; ***alkalis*** such as sodium hydroxide, potassium hydroxide, lithium hydroxide, pyridine and aqueous ammonia; ***inorganic acids*** such as phosphoric acid; ***organic acids*** such as lower monocarboxylic acids, *e.g.*, glacial acetic acid, anhydrous acetic acid, propionic acid and anhydrous propionic acid, or anhydrides thereof, lower dicarboxylic acids, *e.g.*, oxalic acid, fumaric acid, maleic acid and succinic acid, or anhydrides thereof, and trichloroacetic acid; perchloric acid, hydrochloric acid, nitric acid, sulfuric acid, sulfonic acid, p-toluenesulfonic acid and boron

trifluoride and their complexes with electronic donors; *Lewis acids* such as SnCl_4 , ZnCl_2 , FeCl_3 , AlCl_3 , SbCl_3 and TiCl_4 and their complexes. *A preferred catalyst is hydrochloric acid.*

Matsuo, col. 11, line 59 to col. 12, line 10 (emphasis added). The Applicants submit, therefore, that Matsuo does not teach or suggest the use of the specific oxidant solutions selected from the aqueous ozone or hydrogen peroxide solutions as recited in claims 5, 27 and 36, nor does Matsuo recite classes of compounds that include the specific oxidants used in forming these solutions.

The Applicants contend, therefore, that claims 7, 10-16, 21-27, 29, 30, 36-39, 41-46 and 48-51 are allowable over the art of record in this application. The Applicants request, therefore, that the present rejections be reconsidered and withdrawn accordingly.

Allowable Subject Matter

The Applicants again note with appreciation the Examiner's indication that claims 5, 6, 8, 9, 17-20, 28, 31-33, 40 and 47 are objected to as depending from a rejected base claim and would, therefore, be allowable if rewritten in independent form incorporating limitations of all included claims. As reflected by the amendments and remarks presented above, the Applicants have rewritten claim 5 in independent form and have incorporated corresponding amendments in independent claims 27 and 36. The Applicants submit, therefore, that each of these independent claims and each of the claims that depends therefrom, whether directly or indirectly, is now in condition for allowance.

Allowed Claims

The Applicants again note with appreciation the Examiner's indication that claims 34 and 35 are allowed.

CONCLUSION

In view of the remarks presented above, the Applicants submit that each of the pending objections and rejections have been addressed and overcome, leaving each of the claims of the present application in condition for allowance. A notice to that effect is requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge any underpayment or non-payment of any fees required under 37 C.F.R. §§ 1.16 or 1.17, or credit any overpayment of such fees, to Deposit Account No. 08-0750, including, in particular, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

By: _____

John A. Castellano
Reg. No. 35,094
P.O. Box 8910
Reston, VA 20195
(703) 668-8000


JAC/GPB